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| APPLICATION NO.      | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO.    |
|----------------------|-------------|----------------------|---------------------|---------------------|
| 09/939,726           | 08/28/2001  | Rafael Storz         | 016790-0432         | 2703                |
| 22428                | 7590        | 06/28/2004           | EXAMINER            |                     |
| FOLEY AND LARDNER    |             |                      |                     | FULLER, RODNEY EVAN |
| SUITE 500            |             |                      |                     |                     |
| 3000 K STREET NW     |             |                      |                     |                     |
| WASHINGTON, DC 20007 |             |                      |                     |                     |
|                      |             |                      |                     | ART UNIT            |
|                      |             |                      |                     | PAPER NUMBER        |
|                      |             |                      |                     | 2851                |

DATE MAILED: 06/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                      |                     |
|------------------------------|----------------------|---------------------|
| <b>Office Action Summary</b> | <b>Applicant No.</b> | <b>Applicant(s)</b> |
|                              | 09/939,726           | STORZ ET AL.        |
|                              | <b>Examiner</b>      | <b>Art Unit</b>     |
|                              | Rodney E Fuller      | 2851                |

-- The MAILING DATE of this communication appears on the cover sheet with the corresponding address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 05 April 2004.
- 2a) This action is **FINAL**.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) 4-13 and 21 is/are allowed.
- 6) Claim(s) 1-3, 14-20 and 22-29 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on April 5, 2004 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

Rodney Fuller  
Primary Examiner

#### Attachment(s)

|  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                     | Paper No(s)/Mail Date. _____ .  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____ .                                  |

**DETAILED ACTION*****Remarks***

1. In response to applicant's Amendment, dated April 5, 2004, the examiner acknowledges the addition of claim 29. Claims 1-29 are pending.
2. Regarding the 35 U.S.C. 102(e) rejection of claims 1-28 as being anticipated by Karpol, et al. (US 6,369,888), the applicant (as noted in the Interview Summary, mailed April 16, 2004) amended the claim 1 to include the limitation of a microscope. The examiner maintains that Karpol teaches a confocal microscope, even though it does not expressly use the term "microscope." Thus, the examiner maintains the rejection related to claims 1-3, 14-18 and 22-29. (Claims 2, 3, 14, 15 and 29 depend from claim 1.) (Claims 17, 18 and 22 depend from claim 16.) (Claims 24-28 depend from claim 23).
3. Regarding claim 4, the applicant argues that Karpol does not utilize a modulator that is either a mirror, a lens or a beamsplitter. The examiner acknowledged (Interview Summary, dated April 16, 2004) that Karpol teaches the use of only an acousto-optic or electro-optic modulator and not a mirror, a lens or a beam splitter as a modulator. Regarding claim 6, the examiner further acknowledged that the modulator is not moved in Karpol. Regarding claim 7, the examiner acknowledged that Karpol does not use a piezo element. Thus, the examiner withdraws the rejection related to claims 4-7 and 21. (Claims 5-7 and 21 depend from claim 4)
4. Regarding claim 8, the examiner acknowledged (Interview Summary, dated April 16, 2004) that Karpol does not teach wherein the modulator influences the laser light source. Thus, the examiner withdraws the rejection of claims 8-13. (Claims 9-13 depend from claim 8).

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5. Regarding claims 19 and 20, the applicant makes the argument that Karpol fails to teach an acousto-optical filter or beamsplitter. The examiner maintains that Karpol does teach an acousto-optical filter (modulator) (See Figure 8, ref.# 331). Thus, the examiner maintains the rejection of claims 19 and 20.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-3, 14-20 and 22-29 are rejected under 35 U.S.C. 102(e) as being anticipated by Karpol, et al. (US 6,369,888).

Karpol discloses all the structure set forth in the claims. On page 2, lines 22-25 of the Summary Of The Invention, the specification states: “*According to the invention, it has been recognized for the first time that disruptive interference phenomena in the optical beam path can be avoided if the coherence length of the light emitted by the laser light source is less than the optical path in the illumination beam path.*” Likewise, Karpol discloses (abstract): “*... that light beams output by the element combinations have optical path length differences that are greater than a coherence length of the light beam output by the coherent light source.*”

Regarding the claims 23-28, Karpol discloses "...to illuminate an object (Fig. 1A, ref.# 2) with light from a laser light source (Fig. 1A, ref.# 4), comprising a modulator (Fig. 1A, ref.# 30) adapted to vary the phase angle of a light filed of the light in such a way that interference phenomena does not occur in an optical beam path of the microscope, or occurs only to an insignificant extent, within a predetermined time interval." Further, it has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchinson*, 69 USPQ 138.

The method steps of claims 1-3, 14-20, 22, 29, are met by the operation of Karpol as applied to claims 23-28.

***Allowable Subject Matter***

8. Claims 4-13 and 21 are allowed.

***Conclusion***

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rodney E Fuller whose telephone number is 571-272-2118. The examiner can normally be reached on 8:00am - 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Lefkowitz can be reached on 571-272-2180. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Rodney E Fuller  
Primary Examiner  
Art Unit 2851



June 23, 2004